

First named inventor: Parry
Serial no. 10/053,411
Filed 11/7/2001
Attorney docket no. 10013282-1

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REMARKS

Claim objections

Claim 4 has been objected to, essentially because it specifies a range at odds with the range of its base independent claim, claim 1. Applicant has cancelled claim 4 without prejudice.

Claim rejections under 35 USC 102

Claims 1-13 and 16-20 have been rejected under 35 USC 102(e) as being anticipated by Young (2004/0205115). Claims 1, 5, and 18 are independent claims, from which the remaining claims ultimately depend. Applicant submits that as amended, claims 1, 5, and 18 are patentable over Young, such that all the pending claims are patentable over Young.

Applicant discusses claim 1 as representative of all the independent claims 1, 5, and 18, insofar as patentability over Young is concerned. The claimed invention has been amended to clarify the differences between the approach for distributing facsimiles of the claimed invention, as compared to the approach for distributing facsimiles disclosed in Young. As before, claim 1 is limited to receiving a facsimile, storing it on a storage media at a specific location, identifying an Internet enabled device associated with each intended recipient of the facsimile, and then notifying each identified Internet enabled device of the specific location at which the facsimile is stored.

Applicant has amended the claimed invention to clarify what is encompassed by this notification in particular. The notification is "so that the identified Internet enabled device can later retrieve said saved facsimile from said specific location." Furthermore, the notification is "made via a notification message to the identified Internet enabled device," where "the notification message [does] not contain[] said saved facsimile." In essence, what is going on here is that an Internet enabled device gets a notification that a facsimile has been received and stored at a specific location. However, the notification itself does not contain the facsimile. Rather, the

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Internet enabled device can later retrieve the facsimile from the specific location at which it is stored.

The patent application as filed provides express and/or inherent support for the limitations added to the claimed invention. For instance, paragraph [0037] notes the following:

The notifications 340 sent by the facsimile distribution center 130 to the intended recipients identify a URL address or location where a facsimile is stored. Upon receiving the identifying notification, an intended recipient may access the specified URL address to download the facsimile.

In paragraph [0037], then, a notification identifies the URL address or location where a facsimile is stored, such that upon receipt, the intended recipient can access the specified URL address to download the facsimile. This is consistent with the added claim language, in which the notification is "so that the identified Internet enabled device [i.e., the intended recipient operating this device] can later retrieve said saved facsimile from said specification location."

Furthermore, in paragraph [0037], the notifications do not include the facsimiles themselves, to which the claimed invention is explicitly limited. This limitation is inherent in the disclosure of paragraph [0037], since if the notifications did include the facsimiles, then there would be no reason for the intended recipient to download the facsimile. That is, the intended recipient downloading the facsimile at the URL address specified in the notification only makes sense if the intended recipient has not already been provided the facsimile, which means that the notification does not include the facsimile itself. Applicant notes that the MPEP states that "[t]he subject matter of [a] claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement." (MPEP sec 2163.02)

The facsimile distribution approach disclosed in Young, by comparison, is different than that of the claimed invention. Whereas the claimed invention notifies an Internet enabled device of the location at which a facsimile is stored, so that the user can download the facsimile, and where the facsimile is not part of the notification itself, Young simply sends the Internet enabled device the facsimile. The Internet enabled device does not have to later retrieve the facsimile in

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response to receiving the notification, because it already has received the facsimile as part of the notification. That is, the notification of Young *contains* the facsimile, in contradistinction to the claimed invention. In this sense, Young cannot anticipate the claimed invention.

For instance, consider FIG. 2 of Young. A facsimile is wrapped in a network transfer protocol in part 206, and then communicated to an Internet enabled device at a URL thereof in part 210, such that the Internet enabled device receives the facsimile as part of the notification in part 212. This process is delineated in the specification of Young, too. “[T]he service provider wraps the converted fax data in a network transfer protocol such as HTTP so that the converted fax data can be sent as a Web page to the EWS [embedded web server] 116 in the printer 114.” (Para. [0024]) “Next, the service provider 10 communicates the web page containing the converted fax data over the Internet 112 to the address of the identified URL.” (Para. [0025]) “In this manner the converted fax is transmitted to the appropriate EWS 116 in the corresponding EWS enabled printer.” (Id.)

In Young, then, the notification from the service provider to the embedded web server of the printer that a facsimile has been received includes the facsimile itself from the service provider to a URL of the embedded web server of the printer. That is, the notification *contains* the facsimile in Young, unlike as in the claimed invention. Indeed, the service provider never sends within the notification the location at which the facsimile is stored, in contradistinction to the claimed invention, because the service provider simply transmits the facsimile to the embedded web server. Also unlike as in the claimed invention, the embedded web server of the printer does not “later retrieve” the facsimile, because it already *has* the facsimile. In this way, Young does not disclose the claimed invention, and therefore cannot anticipate it.

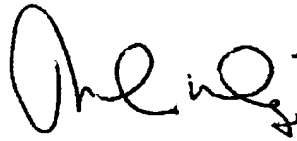
In summary, the approach of the claimed invention for facsimile distribution is to save received facsimiles to storage locations, and then notify the Internet enabled devices of these storage locations so that the devices can download the facsimiles therefrom. This is a “pull” paradigm, by which the Internet enabled device “pulls” the facsimile from the storage location.

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By comparison, the approach of Young for facsimile distribution is to transmit received facsimiles to the Internet enabled devices directly. The received facsimiles are transmitted to particular locations of these Internet enabled devices. This is a "push" paradigm, by which the facsimiles are "pushed" to the Internet enabled device.

Respectfully Submitted,



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